

REMARKS

INTRODUCTION

In accordance with the foregoing, claims 60 and 62 have been amended and claims 32-36, 38, and 39 have been cancelled without prejudice or disclaimer. No new matter is being presented, and approval and entry are respectfully requested. Therefore, since claims 37, 40, and 41 have been previously canceled, claims 1-31, 42-63 are pending and under consideration. Reconsideration is respectfully requested.

ENTRY OF RESPONSE UNDER 37 C.F.R. §1.116

Applicants request entry of this Rule 116 Response and Request for Reconsideration because the amendments of claims 60 and 62 should not entail any further search by the Examiner since no new features are being added and the amendments do not significantly alter the scope of the claims and place the application at least into a better form for appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures sets forth in §714.12 that "[a]ny amendment that would place the case either in condition for allowance or in better form for appeal may be entered." (Underlining added for emphasis) Moreover, §714.13 sets forth that "[t]he Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

RESTRICTION REQUIREMENT

Applicants note with appreciation that claims 32-36, 38, and 39 have been acknowledged to be withdrawn and further note that these claims have been cancelled without prejudice or disclaimer with respect to this application.

REJECTION UNDER 35 U.S.C. §102

In the Office Action, at numbered paragraph 2, claims 60-63 were rejected under 35 U.S.C. §102 in view of Lee (U.S. Patent 6,266,315). This rejection is traversed and reconsideration is requested.

Briefly, claim 60 recites an optical pickup comprising an objective lens. The objective lens comprises a first transmitting portion divergently transmitting an incident light beam, at least one portion converting the diverging light beam to a converging light beam with a light spot external to the objective lens, and a second transmitting portion transmitting only the converging light beam.

Applicants draw attention to the phrase "converting the diverging light beam to a converging light beam with a light spot external to the objective lens," and note that this phrase refers to the fact that the objective lens focuses light "with ultra high resolution . . . on an optical disk 100 for information recording and reproduction." See the specification of the present application at page 6, lines 7-12.

Lee, on the other hand, fails to disclose the claimed invention. This fact is illustrated by FIGS. 2-4C in which the optical focusing system of Lee, which appears to correspond to the claimed objective lens, is equipped with one of a beam focusing surface (reference numeral 204 in FIG. 2), a beam focusing portion (reference numerals 33, 41, and 53 in FIGS. 3A, 3B, and 3C, respectively), a beam focusing portion of a slider (reference numerals 653 and 65 of FIG. 4A, respectively), and a beam focusing surface of a slider (reference numerals 753, 75A, and 75B of FIGS. 4B and 4C). In each case, the beam focusing portion is integrally attached to the optical focusing system and, thus, may be thought of as a part thereof. As such, according to Lee, since the focus point of the beam is within the beam focusing portion or surface, the focus of the beam is necessarily within the optical focusing system.

Moreover, since, as noted above, the optical focusing system of Lee appears to correspond to the claimed objective lens, and since the focus of the beam in Lee is within the optical focusing system, the reference to Lee fails to disclose the claimed "converting the diverging light beam to a converging light beam with a light spot external to the objective lens." Therefore, applicants respectfully assert that claim 60 is patentably distinguished over the prior art and that the rejection is overcome.

Regarding the rejection of claim 62, it is noted that claim 62 also recites "transmitting the altered light beam from the at least another portion to a light spot external to the objective lens," and thus, applicants assert that claim 62 is patentably distinguishing over the prior art for substantially similar reasons as claim 60 and that the rejection is overcome.

Regarding the rejection of claims 61 and 63, it is noted that these claims depend from claims 60 and 62, respectively, and are therefore allowable for at least the reasons as set forth above.

CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

By: 

Howard I. Levy
Registration No. 55,378

Date: August 17, 2004

1201 New York Avenue, N.W.
Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501